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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,369	07/02/2001	Aziz Valliani	A-70469/MAK/LM	2759

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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/899,369	Applicant(s) VALLIANI ET AL.	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/06 has been entered.

Claim Objections

Claims 1-14 and 16-26 objected to because of the following issues:

Examiner first notes that the order of the method steps renders the claims unclear. Specifically, the first step positively recites, "identifying the purchase of a first product." However, in the third step a product is offered for sale only "if" the particular customer makes a purchase. It is unclear how there can be an "if" situation (i.e. no purchase) when the particular customer has already made the purchase in the first limitation. Examiner recommends amending the third limitation to remove the alternative language (i.e. "if" statement). Examiner offers the following suggested language as an example, "at the second company, offering for sale the second product at a discount as a result of the purchase by the particular customer of the first product at the first company."

Examiner notes that a similar issue exists with respect to the fourth limitation, "querying the database to determine if the particular customer makes a purchase." As noted above, how can there be a situation when the first customer doesn't make the purchase, when the first step of

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this claim explicitly recites the particular customer making the purchase. Examiner suggests the following language, “at the second company, querying the database to verify that purchase of the first product by the particular customer from the first company.”

Examiner also notes that the timing of the second limitation is confusing. Specifically, does the first company condition the grant of a discount for a second product after the customer purchases the first product or does it happen at the time when the first company enters into a bilateral cross-marketing relationship with the second company? A review of the specification leads the Examiner to believe that the conditioning occurs before the purchase of the first product.

In a related issue, Examiner notes that Applicant’s current amendment is made to the preamble and is therefore given little patentable weight.

To resolve both of the issues above Examiner recommends amending the claim to remove the second limitation and to add the following step as the first step,

- “establishing the parameters of a bilateral cross-marketing relationship between a first company and a second company wherein the parameters include the second company offering a discount on a second product based on the purchase of a first product from the first company.”

With further respect to the fourth limitation the Examiner finds the following recitation unclear, “standing ready to accept the discount on the second product.” Specifically it is unclear who is accepting the discount. It appears from the claim that the second company is going to

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accept the discount but in based on the Specification it appears that Applicant attends for the particular customer to accept (or receive) the discount from the second company. Examiner suggests removing that language from the fourth limitation and adding the following language as a separate step, “at the second company, providing the discount to the particular customer on the second product.”

With respect to the fifth limitation, Examiner finds it unclear how the amount of cross-marketing revenue is calculated and recorded. Specifically, how does a first company know whether a purchase of a first product is the result of the cross-marketing or just a customer purchasing the product on his/her own. Does the first company simply add a set amount to the marketing fund every time a particular product is sold, or does some other event (e.g. user registers for the discount, or the actual purchase of the second product) trigger the transfer of the funds?

Applicant has argued that bilateral cross-marketing relationship combined with the cross-marketing revenue in the marketing fund are what the prior art of record lacks. If these concepts hold the novel features Examiner believes they need to be explained. Looking at the Specification (paragraph bridging pages 8 and 9) it appears that Applicant’s invention includes the first company recording a percentage of all straight sales of promoted items to the fund. (A straight sale is defined by Applicant on page 6, lines 3-4 as “a sale to the consumer without involving the alliance network). The 2nd company then reclaims these funds as consumers make purchases of the 2nd product at the 2nd company. It also appears that the first company

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contributes to the alliance fund as a result of incremental referral sales made by customers at the 1st company.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 3-14 and 16-26 rejected under 35 U.S.C. 102(e) as being anticipated by Jacoves (US Patent Number 6,741,968).

Jacoves teaches identifying the purchase of the first product of a first company by a particular customer at a first point-of-sale terminal and storing an indication of the purchase of the first product in a database on a server (see for example column 3, line 62 through column 4, line 5 and column 7, lines 35-38).

Jacoves teaches at the first company, conditioning the grant of a discount for a second product at a second company on the purchase of the first product at the first company (see for example column 3, lines 14-45).

Jacoves teaches at the second company, offering for sale the second product if the particular customer makes a purchase of the first product (see for example column 4, lines 9-18).

Jacoves teaches at the second company querying a database to determine if the particular customer has purchased the first product and standing ready to accept the discount on the second product (see for example column 7, lines 38-61).

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Jacoves teaches calculating and recording an amount of cross-marketing revenue realized from the first purchase to a marketing fund account in the database and allocating at least a portion of the cross-marketing revenue in the fund to reimburse the second company for the discount (see for example column 4, lines 25-40 and the paragraph bridging columns 8 and 9).

Examiner notes that Jacoves further teaches the discount of less than 100% as well as a total 100% discount (see for example column 3, lines 30-40), crediting an account of the consumer with the discount, notifying the consumer of the discount, depositing money to the clearing house (marketing fund).

Examiner notes that Jacoves further teaches that this cross-marketing relationship can exist between separate companies or between different departments within one company (i.e. a gas station that sells both gas and groceries, where the purchase of groceries (1st department) warrants a discount on the purchase of gas (2nd department).

Response to Arguments

Applicant's arguments with respect to claims 1-14 and 16-26 have been considered but are moot in view of the new ground(s) of rejection.

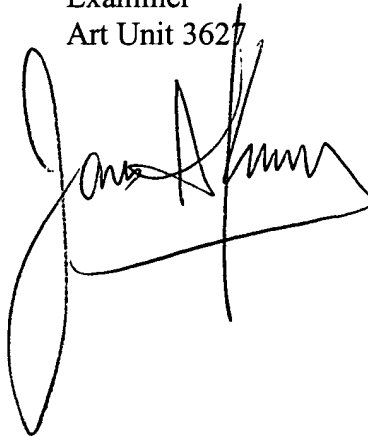
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Kramer
Examiner
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A handwritten signature in black ink, appearing to read 'James A. Kramer', with a large, stylized loop on the left side.

jak
8/10/06